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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 1280-SC12984ZC

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on April 28, 2006

Signature: Jennifer Jensen

Typed or printed name: Jennifer Jensen

Application Number	Filed
10/802,018	March 16, 2004

First Named Inventor: Nihal J. GODAMBE

Art Unit	Examiner
2817	Joseph CHANG

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 42,146
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Adam D. Sheehan
Typed or printed name

512-439-7100
Telephone number

April 28, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Nihal Godambe, et. al.		
Title:	SELF-CALIBRATING OSCILLATOR SYSTEM		
App. No.:	10/802,018	Filed:	03/16/2004
Examiner:	CHANG, Joseph	Group Art Unit:	2817
Customer No.:	34814	Confirmation No.:	2669
Atty. Dkt. No.:	1280-SC12984ZC		

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Final Office Action mailed December 28, 2005 (hereinafter, "the Final Action") and the Advisory Action mailed March 10, 2006 (hereinafter, "the Advisory Action"), and pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, the Applicants request review of the following issues on appeal.

Claims 1-4—The cited art fails to disclose the recited elements of " a rectifier"and "a reference output to provide a rectified signal"

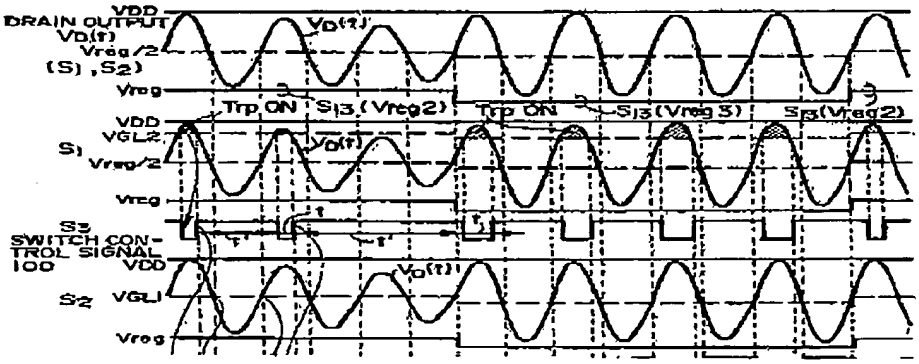
Claims 1-4 are rejected under 35 U.S.C. Section 102(b) as being anticipated by Nakamiya (U.S. Patent No. 6,166,609). Claim 1 recites "a rectifier comprising an input coupled to the oscillation output, and a reference output to provide a rectified signal." This element is not disclosed by Nakamiya. According to the Final Action, item 30 of FIG. 1 of Nakamiya discloses a rectifier. *Final Action*, p. 2. However, Nakmiya plainly discloses that item 30 is not a *rectifier*, but instead is a *switching element*. *Nakamiya*, col. 6, lines 38-40 ("switching element 30 for blocking the output at the output stage of the signal inversion amplifier 20.") Nakamiya futher teaches that "the output-blocking

switching element 30 is provided in the output stage of the signal inversion amplifier 20 of this embodiment so that, when the transistor 40 is controlled to be off, this output-blocking switching element 30 is also used *to provide off-control.*" *Id*, col. 6, lines 46-53 (emphasis added). Thus, Nakamiya explicitly discloses that item 30 is a switching element used to provide off-control, not a rectifier as disclosed in the claims.

The Final Action alleges that the element 30 is a rectifier because a rectifier is "a device that corrects [an] incoming signal." *Final Action*, p. 2. Applicant respectfully submits that the Final Action's understanding of the term "rectifier" is in error. As indicated by the exemplary definitions submitted as Appendix I of Applicant's Response to Final Office Action, rectification involves conversion of an alternating current (AC) signal to some form of a direct current (DC) signal, such as by half-wave rectification or full-wave rectification. The output of a typical rectifier is a pulsing DC signal or a constant DC signal. Thus, the Final Action's interpretation of the claim term "rectifier" is inconsistent with the ordinary and customary meaning that the PTO musgt accord to the term "rectifier." *See* MPEP Section 2111.2.

Further, claim 1 recites that the rectifier includes a reference output to provide a rectified signal. Switching element 30 of Nakamiya does not include such an output. As illustrated by FIG. 1 of Nakamiya, switching element 30 provides an output signal labeled $V_D(t)$. For ease of reference, a portion of FIG. 2 is set forth below:

FIG. 2



Accordingly, as illustrated in FIG. 2, the output of the switching element 30 ($V_D(t)$) is an *unrectified AC signal*. Thus, the switching element 30 is not a rectifier and does not provide a rectified signal as recited by claim 1.

Claims 2-4 and 12 depend from claim 1. Accordingly, Nakamiya fails to disclose each and every element of these claims, at least by virtue of their dependency on claim 1.

The Examiner has set forth improper grounds for the rejection of claims 16-18

Claim 16 is rejected under 35 U.S.C. Section 102(b) as being anticipated by Nakamiya. The claim recites "monitoring within a System On a Chip (SOC) device an oscillation output of a signal controlled oscillator of the SOC device to determine an operating condition of the signal controlled oscillator." Nakamiya does not disclose a System On A Chip. In fact, the Advisory Action acknowledges that this element is not disclosed by Nakamiya. *Advisory Action*, p. 2. Accordingly, Nakamiya fails to disclose each and every element of claim 16.

The Advisory Action states that "one of ordinary skill in the art would recognize the device of Nakamiya et. al. as "system on a chip." *Id.* This is improper as a basis for the anticipation rejection of the claim under 35 U.S.C. Section 102(b). The Examiner appears to be constructing an "Official Notice"-type Section 103 rejection. However, the Examiner has not explicitly rejected claim 16 under Section 103, and therefore the Applicants have not been afforded an opportunity to challenge the Examiner's Official Notice, as permitted under MPEP Section 2144.03. Accordingly, the rejection of claim 16 is improper.

Claims 17-18 and 24-25 depend from claim 16. Accordingly, Nakamiya fails to disclose each and every element of these claims, at least by virtue of their dependency on claim 16.

The Examiner has failed to give any support for the rejection of claim 26

With respect to claim 26, the Final Action indicates at page 2 that the claim is rejected based on Nakamiya. The only reason set forth for the rejection is alleged in the Office Action of August 1, 2005, which states that the methods of claim 26 are "inherently present in the structure of device of Nakamiya." *August 1, 2005 Office*

Action, page 3. However, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has failed to make any showing that the method of claim 26 necessarily flows from the disclosure of Nakamiya. Accordingly, the Examiner has failed to establish a prima facie case that Nakamiya discloses or suggests each and every element of claim 26.

Claims 13-15 are allowable

At page 2 of the Office Action, claims 13-15 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Namakiya in view of Heinonen (U.S. Application Publication No. 2003/0060176).

Claims 13-15 depend from claim 1. As explained above, Nakamiya does not disclose each and every element of claim 1. Accordingly, Nakamiya fails to disclose each and every element of claims 13-15, at least by virtue of their dependency on claim 1. Further, Heinonen fails to disclose the elements that are lacking in Nakamiya. Accordingly, Nakamiya and Heinonen, individually and in combination, fail to disclose or suggest each and every element of claims 13-15. For at least this reason a prima facie rejection of claims 13-15 under § 103 has not been established.

Conclusion

The Applicants respectfully submit that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Applicants believe no additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-0441.

Respectfully submitted,

4/28/06
Date

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